

***REMARKS***

This is a full and timely response to the outstanding Office action mailed April 28, 2005. Upon entry of the amendments in this response, claims 1 and 3-20 are pending. More specifically, claims 1 and 13 are amended. These amendments are specifically described hereinafter. It is believed that the foregoing amendments add no new matter to the present application.

**I. Present Status of Patent Application**

Claims 1, 3-12, 18, and 20 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Stewart in view of Walsh and Baker. Claims 13-17 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Stewart in view of Walsh. Claim 19 is rejected under 35 U.S.C §103(a) as allegedly being unpatentable over Stewart in view of Walsh and Hidary. To the extent that these rejections have not been rendered moot by the cancellation of claims, they are respectfully traversed.

**II. Examiner Interview**

Applicants first wish to express sincere appreciation for the time that Examiner Brandon J. Miller spent with Applicants' Agents and Attorneys Jeff Kuester and Benjie Balser during a July 6, 2005 telephone discussion regarding the above-identified Office Action. Applicants believe that various features described in the patent application and recited in the claims, including sending advertisements from a content provider without location and identity information were discussed during the telephone discussion, and that the outcome of this discussion is addressed herein. During that conversation, Examiner Brandon J. Miller seemed to indicate that it would be potentially beneficial for Applicants to file this amendment and response. Thus, Applicants respectfully request that Examiner Brandon J. Miller carefully consider this amendment and response.

### III. Rejections Under 35 U.S.C. §103(a)

#### A. Claims 1 and 3-12

The Office Action rejects claims 1 and 3-12 under 35 U.S.C. §103(a) as allegedly being unpatentable over Stewart in view of Walsh and Baker. For at least the reasons set forth below, Applicants respectfully traverse the rejection.

**Independent claim 1, as amended, recites:**

1. A method of sending an advertisement to a user operating a wireless communication device, comprising:
  - receiving first information about the identity of the user;
  - receiving second information about a location of the user;
  - searching a first database of an advertisement provider containing one of a plurality of user-specific advertisements and a plurality of location-specific advertisements;
  - accessing a second database containing a plurality of user-specific preferences;
  - identifying one or more preferences in the second database that are associated with the user;
  - selecting one of the plurality of user-specific advertisements and the plurality of location-specific advertisements based on the one or more preferences in the second database; and
  - sending one of the plurality of user-specific advertisements from the advertisement provider to the wireless communication device* in the form of a TCP/IP (Transmission Control Protocol/Internet Protocol) message over a communication network *without transmitting an indication of the location of the user therewith from the advertisement provider and* the plurality of location-specific advertisements to the wireless communication device in the form of a TCP/IP (Transmission Control Protocol/Internet Protocol) message over a communication network

***without transmitting an indication of the identity of the user therewith from the advertisement provider.***

For a proper rejection of a claim under 35 U.S.C. §103, the cited combination of references must disclose, teach, or suggest all elements/features/steps of the claim at issue. *See, e.g., In re Dow Chemical.*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988) and *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981). Applicants respectfully submit that independent claim 1 is allowable for at least the reason that no combination of Stewart, Walsh and Baker discloses, teaches, or suggests at least **sending one of the plurality of user specific advertisements from the advertisement provider to the wireless communication device ... without transmitting an indication of the location of the user therewith from the advertisement provider and ...without transmitting an indication of the identity of the user therewith from the advertisement provider.**

The cited combination of references does not disclose, teach, or suggest, either implicitly or explicitly, all the elements of claim 1. Therefore, the rejection should be withdrawn. Additionally and notwithstanding the analysis hereinabove, there are other reasons why claim 1 is allowable.

Because independent claim 1 is allowable over the cited art of record, dependent claims 3-12 (which depend from independent claim 1) are allowable as a matter of law for at least the reason that dependent claims 3-12 contain all the steps/features of independent claim 1. *See Minnesota Mining and Manufacturing Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002) *Jeneric/Pentron, Inc. v. Dillon Co.*, 205 F.3d 1377, 54 U.S.P.Q.2d 1086 (Fed. Cir. 2000); *Wahpeton Canvas Co. v. Frontier Inc.*, 870 F.2d 1546, 10 U.S.P.Q.2d 1201 (Fed. Cir. 1989). Therefore, the rejection to claims 3-12 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 1, dependent claims 3-12 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited art of record. Hence there are other reasons why dependent claims 3-12 are allowable.

B. Claims 13-20

The Office Action rejects claims 13-17 under 35 U.S.C. §103(a) as allegedly being unpatentable over Stewart in view of Walsh. The Office Action rejects claims 18 and 20 under 35 U.S.C. §103(a) as allegedly being unpatentable over Stewart in view of Walsh and Baker. The Office Action rejects claim 19 under 35 U.S.C. §103(a) as allegedly being unpatentable over Stewart in view of Walsh and Hidary. For at least the reasons set forth below, Applicants respectfully traverse the rejection.

**Independent claim 13, as amended, recites:**

13. A method of sending an advertisement over a communication network to a user operating a wireless communication device, comprising:
- receiving first information about the identity of the user;
  - receiving second information about a location of the user;
  - searching a database of a content provider containing one of a plurality of user-specific advertisements and a plurality of location-specific advertisements;
  - selecting one of the plurality of user-specific advertisements and the plurality of location-specific advertisements based on one or more criteria pre-selected by the user; and
- sending one of the plurality of user-specific advertisements from the content provider to the wireless communication device over the communication network without transmitting the second information about the location of the user therewith from the content provider and the plurality of location-specific advertisements to the wireless communication device over the communication network without transmitting the first information about the identity of the user therewith from the content provider.*

Applicants respectfully submit that independent claim 13, as amended, is allowable for at least the reason that no combination of Stewart, Walsh, Baker or Hidary discloses, teaches, or suggests at least **sending one of the plurality of user specific advertisements from the content provider to the wireless communication device ...without transmitting an indication of the location of the user therewith from the content provider and ...without transmitting an indication of the identity of the user therewith from the content provider.**

As shown above, the cited combination of references does not disclose, teach, or suggest, either implicitly or explicitly, all the elements of claim 13. Therefore, the rejection should be withdrawn. Additionally and notwithstanding the analysis herein above, there are other reasons why claim 13 is allowable.

Because independent claim 13 is allowable over the cited art of record, dependent claims 14-20 (which depend from independent claim 13) are allowable as a matter of law for at least the reason that dependent claims 14-20 contain all the steps/features of independent claim 13. Therefore, the rejection to claims 14-20 should be withdrawn and the claims allowed. Additionally and notwithstanding the foregoing reasons for allowability of independent claim 13, dependent claims 14-20 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited art of record. Hence there are other reasons why dependent claims 14-20 are allowable.

Additionally, with regard to the rejection of claims 18 and 20, Baker does not make up for the deficiencies of Stewart and Walsh noted above. Further, with regard to claim 19, Hidary does not make up for the deficiencies of Stewart and Walsh noted above. Therefore, claims 18-20 are considered patentable over any combination of these documents.

#### **IV. Miscellaneous Issues**

Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, or statements interpreted similarly, should not be considered well known

since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions.

**CONCLUSION**

In light of the foregoing amendments and for at least the reasons set forth above, Applicant respectfully submits that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims 1 and 3-20 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned agent at (770) 933-9500.

Respectfully submitted,



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